



PATENT
Serial No: 10/614,861
Docket No: 29284-596

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Yasuo Inoue
Application No.: 10/614,861
Filed: July 9, 2003
For: EXTERNAL STORAGE SUBSYSTEM
Group Art Unit: 2182
Examiner: Alan S. Chen

COMMUNICATION

Mail Stop - RCE

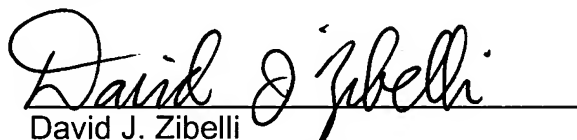
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Attached hereto is a Statement of Facts concerning the prior art submitted in the Information Disclosure Statement concurrently filed herewith. If the Examiner has any questions, he is invited to contact the undersigned.

Respectfully submitted,

KENYON & KENYON


David J. Zibelli
Registration No. 36,394

Date: July 28, 2005

Kenyon & Kenyon
1500 K Street, N.W. – Suite 700
Washington, D.C. 20005
Telephone: (202) 220-4200
Facsimile: (202) 220-4201

Attachment: Statement of Facts



Serial No. 10/614,861
Docket No. 29284/596

Statement of Facts

1. This application (S/N 10,614,861) is one of six co-pending continuation applications, all claiming priority to the same parent application (S/N 09/819,636). The other co-pending continuation applications are 10/614,859, 10/614,860, 10/614,862, 10/614,863, and 10/614,864.
2. The current 10/614,861 application and the co-pending continuation applications are all entitled to an effective US filing date of December 3, 1992, due to the chain of parent applications of which they claim benefit, and are entitled to a foreign priority date of December 6, 1991, due to the claim for priority under 35 USC 119 from JP 03-322965.
3. US Patent 5,819,054 (hereinafter the '054 patent) is not prior art against the current 10/614,861 application or the co-pending continuation applications, because it has an earliest effective US filing date of June 21, 1994.
4. The inventor of the current application, Yasuo Inoue is a co-inventor of the '054 patent.
5. The '054 patent indicates in the "Description of the Related Art" that JP-B-61-43742 (corresponding to U.S. Pat. No. 4,636,946) discloses a conventional storage system connected to a large-scale computer, and refers to FIG. 20 as a schematic of a conventional storage system, illustrating the connection of host adaptors, host computers, disk adaptors, cache memory, host adaptors and shared management memory.
6. JP-B-61-43742 and U.S. Pat. No. 4,636,946 disclose that the cache and channel adaptor are connected by a common bus, and do not disclose the content of FIG. 20 of the '054 patent.
7. The inventor Yasuo Inoue was involved in preparation of the Japanese priority document, JP 05-162021 from which the '054 patent claims priority. In that Japanese priority document, Inventor Yasuo Inoue mistakenly indicated that JP-B-61-43742 contained these disclosures. This mistake was carried over into filing of the US application that matured into the '054 patent.
8. Inventor Yasuo Inoue should have referred in the '054 patent to JP 03-322965 as disclosing the content described in association with FIG. 20 of the '054 patent. FIG. 20 was derived from Fig. 7 of JP 03-322965, a copy of which is attached (with machine translation).
9. Based on the above facts, FIG. 20 and the associated description of the '054 patent are not prior art against the current 10/614,861 application and the co-pending 10/614,859, 10/614,860, 10/614,862, 10/614,863, and 10/614,864 continuation applications.



PATENT
Serial No: 10/614,861
Docket No: 29284-596

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: Yasuo Inoue
Application No.: 10/614,861
Filed: July 9, 2003
For: EXTERNAL STORAGE SUBSYSTEM
Group Art Unit: 2182
Examiner: Alan S. Chen

INFORMATION DISCLOSURE STATEMENT

Mail Stop - RCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 CFR § 1.56, the attention of the Patent and Trademark Office is hereby directed to the reference(s) listed on the attached PTO-1449. Unless otherwise indicated herein, one copy of each reference is attached. It is respectfully requested that the information be expressly considered during the prosecution of this application, and that the reference(s) be made of record therein and appear among the "References Cited" on any patent to issue therefrom. The filing of this Information Disclosure Statement and the enclosed PTO Form No. 1449, shall not be construed as an admission that the information cited is prior art, or is considered to be material to patentability as defined in 37 C.F.R. § 1.56(b). The paragraphs marked below are applicable. It is believed that no fees other than those indicated below are due, but authorization is hereby given to charge any additional fees due, or to credit any overpayment, to deposit account 11-0600.

☒ 1. This Information Disclosure Statement is being filed (a) within three months of the filing date of a national application other than a continued prosecution application under 37 C.F.R. §1.53(d), (b) within three months of the date of entry of the national stage as set forth in 37 C.F.R. § 1.491 in an international application, (c) before the mailing date of a first Office Action on the merits in the present application, OR (d) before the mailing of a first office action after filing of a request for continued examination. No certification or fee is required.

☐ 2. This Information Disclosure Statement is being filed more than three months after the U.S. filing date AND after the mailing date of the first Office Action on

the merits, but before the mailing date of a final action, Notice of Allowance, or any action that otherwise closes prosecution.

- ☐ a. I hereby certify that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(1).
- ☐ b. I hereby certify that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(2).
- ☐ c. Please debit Deposit Account No. 11-0600 in the amount of \$180.00 in payment of the fee under 37 CFR §1.17(p) to ensure consideration of the disclosed information. Two duplicate copies of this paper are attached. 37 CFR §1.97(c)(2).
- ☐ 3. This Information Disclosure Statement is being filed after the mailing date of a final action, Notice of Allowance or an action that otherwise closes prosecution, but before payment of the Issue Fee. Applicant(s) hereby request(s) that the Information Disclosure Statement be considered. Please debit Deposit Account No. 11-0600 in the amount of \$180.00 in payment of the petition fee under 37 CFR §1.17(p) to ensure consideration of the disclosed information. Two duplicate copies of this paper are attached.
- ☐ a. I hereby certify that each item of information contained in this Information Disclosure Statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(1).
- ☐ b. I hereby certify that no item of information in this Information Disclosure Statement was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this Information Disclosure Statement. 37 CFR §1.97(e)(2).
- ☐ 4. Relevance of the non-English language reference(s) is discussed in the present specification.
- ☐ 5. The reference(s) was/were cited in a counterpart foreign application. An English language version of the foreign search report is attached for the Examiner's information.

PATENT

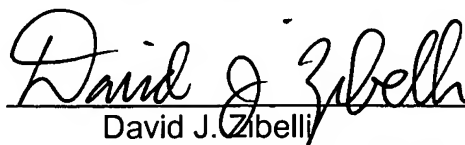
Serial No: 10/614,861

Docket No: 29284-596

- ☐ 6. A concise explanation of the relevance of the non-English language reference(s) appears in the Appendix attached hereto.
- ☐ 7. The Examiner's attention is directed to co-pending U.S. Patent Application No. _____, filed, which is directed to related technical subject matter. The identification of this U.S. Patent Application is not to be construed as a waiver of secrecy as to that application now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited application and the art cited therein during examination of the present application.
- ☐ 8. This application is one of a series of related applications, identified in the attached Appendix, which are directed to related technical subject matter. The identification of those U.S. Patent Applications is not to be construed as a waiver of secrecy as to those applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during the examination.
- ☐ 9. The reference(s) was/were cited by or submitted to the Office in parent application No. _____, filed _____, which is relied upon for an earlier filing date under 35 U.S.C. §120. Thus, copies of these references are not attached. 37 CFR §1.98(d).
- ☐ 10. English-language Abstracts of the non-English language references are attached hereto.
- ☐ 11. Since this application was filed after June 30, 2003, copies of U.S. references are not included.
- ☒ 12. JP 61-043742 corresponds to USP 4,636,946.

Respectfully submitted,

KENYON & KENYON


David J. Zibelli

Registration No. 36,394

Date: July 28, 2005

Kenyon & Kenyon
1500 K Street, N.W. – Suite 700
Washington, D.C. 20005
Telephone: (202) 220-4200
Facsimile: (202) 220-4201

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheet 1 of 1

Complete if Known

| | |
|------------------------|--------------|
| Application Number | 10/614,861 |
| Filing Date | July 9, 2003 |
| First Named Inventor | Yasuo Inoue |
| Group Art Unit | 2182 |
| Examiner Name | Alan S. Chen |
| Attorney Docket Number | 29284-596 |

U.S. PATENT DOCUMENTS

| Examiner Initials * | Cite No. ¹ | Document Number | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|------------------------|--------------------------|--|--------------------------------|--|---|
| | | Number - Kind Code ² (if known) | | | |
| | | US-4,636,946 | 1/13/1987 | Hartung, <i>et al.</i> | |
| | | US- | | | |
| | | US- | | | |
| | | US- | | | |
| | | US- | | | |
| | | US- | | | |
| | | US- | | | |

OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS

| Examiner Initials * | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. |
|------------------------|--------------------------|---|
| | | |
| | | |

FOREIGN PATENT DOCUMENTS

| Examiner Initials * | Cite No. ¹ | Foreign Patent Document | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear | T ⁶ |
|------------------------|--------------------------|---|-----------------------------------|---|--|----------------|
| | | Country Code ³ - Number ⁴ - Kind Code ⁵ (if known) | | | | |
| | | JP 61-43742 (this corresponds to USP 4,636,946) | 9-29-1986 | Hartung, <i>et al.</i> | | |
| | | | | | | |
| | | | | | | |
| | | | | | | |
| | | | | | | |
| | | | | | | |

Examiner
Signature

Date
Considered

* EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04.

³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.